

REMARKS

Applicants have studied the Office Action dated May 18, 2004 and have made amendments to the claims. It is submitted that the application, as amended, is in condition for allowance. Claims 23-30 have been added. By virtue of this amendment, claims 9-10 and 12-16 and 23-30 are pending. Reconsideration and further examination of the pending claims in view of the above amendments and the following remarks is respectfully requested. In the Office Action, the Examiner:

- rejected claims 1-3, 5-10, 12, and 13 under 35 U.S.C. §103(a) as being anticipated by Herz et al. (U.S. 6,571,279) in view of Granick et al (U.S. 2002/0010757); and
- rejected claims 14-19 under 35 U.S.C. §103(a) as being anticipated by Herz et al. (U.S. 6,571,279) in view of Burke et al (U.S. 6,604,681) and further in view of Stewart (U.S. 6,452,498).

Overview of the Present Invention

Preferred embodiments of the present invention are directed to a combination of Global Positioning System (GPS), Personal Data Assistant (PDA), and wireless communications in order to create a more personalized advertising experience. The invention creates and presents advertising content founded on individual user profiles integrated with the physical geographic location of a consumer. The present invention solves the problem of advertising tailored so that it is appropriate to both the user and their current location by including a customer's profile and his / her current location into the advertising message. Also, the invention integrates location tracking, e.g. GPS technology, with a personal electronic calendaring system. Further, an advertising message is more personalized by using a relative address / directions that start from the current customer's location. This information could be provided in the form of driving directions, using the current physical position of the user as a start address. See Abstract of the specification of the present invention.

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Further, the present invention includes the speed and direction i.e. velocity of the movement of PDA. The velocity is determined by retrieving at least two location records along with the time lapse between the location records. Unlike the prior art systems the use of velocity, as well as current location, permits the targeting of not only more precise advertising i.e. traveling north or south on a freeway, but the corresponding map and directions are tailored in response to the velocity measured. Accordingly, precise directions based on a user of the PDA's current speed and direction are delivered as opposed to relative directions of the prior art. Support for this is found in the specification of the present invention at least at page 12, lines 23-29, page 22, lines 1-5, page 25, lines 7-20, and FIG. 7, item 710.

Rejection under 35 U.S.C. §103(a) Hertz in view of Granik

As noted above, the Examiner rejected claims 1-3, 5-10, 12, and 13 under 35 U.S.C. §103(a) as being anticipated by Herz et al. (U.S. 6,571,279) in view of Granik et al (U.S. 2002/0010757).¹ As an initial matter, claims 1-3, 5-8 have been cancelled without prejudice or disclaimer rendering the rejection to claims 1-3, and 5-8 moot. Further, claims 23-30 have been added. Claims 23-26 are computer product claims with limitations similar to method claims 9-10, and 12-13. Claims 26-30 have been added as apparatus claims with limitations similar to method claims 9-10, and 12-13. Accordingly, the following remarks apply to claims 9-10, 12-13, and 23-30 as well.

Independent claim 9 (likewise new independent new claims 23 and 27) have been amended to clarify over Hertz taken alone and/or in view of Granik by reciting

receiving location data and user profile data from at least one mobile information processing unit, wherein the location data includes at least two records for determining a velocity of movement of the mobile information processing unit ;

generating a personalized advertisement which includes a map which is based upon the location data as well as a user profile data associated with the

¹ Applicants make no statement whether such combination is even proper.

mobile information processing unit, wherein the map provides directional information dependent on the velocity of movement of the mobile information processing system to a sales location linked to the advertisement; and
forwarding the personalized advertisement to the mobile information processing unit for display.

Hertz taken alone or in view of Granik does not teach velocity i.e. both speed and direction the mobile device is traveling. This is important to provide accurate directions based on the direction in which the current user of the PDA is traveling i.e. "wherein the map provides directional information dependent on the velocity of movement of the mobile information processing system to a sales location linked to the advertisement." Accordingly, independent claims 9 and 23 and 27 distinguish over Hertz taken alone and/or in view of Granik for at least this reason.

For the foregoing reasons, independent claims 9, 23 and 27 as amended distinguish over Hertz taken alone or in view of Granik. Claims 10, 12-13, 24-26, and 28-30 depend from claims 9, 23, and 27 respectively. Since dependent claims contain all the limitations of the independent claims, claims 9, 23, and 27 distinguish over Hertz in view of Granik, as well, and the Examiner's rejection should be withdrawn.

Regarding claims 12 and 13 (likewise new dependent claims 25, 26, and 29, 30), the advertisement includes user profile data, such as name, interests, age, background, education, hobbies and other personalized data relating to the user i.e. "adding at least part of the user profile data to the advertisement for display on the mobile information processing unit." The Examiner on page 8 of the Office Action cites Hertz (see column 17, lines 34-65; column 6, lines 16-34.) However, careful reading of Hertz discloses using the user profile data as the criteria to select a message in the advertising database for the most relevant advertisement. The present invention goes further than the prior art by not only using the user profile data to select the most relevant advertisement from the database, but to also part of the user profile data to the

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advertisement being delivered itself. Hertz is silent on dynamically including profile data as part of the advertisement to make the advertisement more personalized, such as, *"Hello John Doe, the DVD player you are looking for is available at Big Discounter Electronics which is 2 miles up the road in the direction you are traveling."* Where the user profile data includes "John Doe", "DVD Player" and the location data including velocity allows the pinpoint determination of *"in the direction you are traveling."* Hertz taken alone and/or in view of Granik does not suggest or teach adding personalized user data to the advertisement itself. Accordingly, the claims 12 and 13 (likewise new dependent new claims 25, 26, and 29, 30) distinguish over Hertz taken alone and/or in view of Granik for at least this reason as well.

Continuing further, when there is no suggestion or teaching in the prior art for "map provides directional information dependent on the velocity of movement of the mobile information processing system to a sales location linked to the advertisement" and for "adding at least part of the user profile data to the advertisement for display on the mobile information processing unit" the suggestion can not come from the Applicant's own specification. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP §2143 and Grain Processing Corp. v. American Maize-Products, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and In re Fitch, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The prior art reference Hertz taken alone and/or in view of Granik does not even suggest, teach or mention velocity, direction or adding user profile data to the advertisement. Accordingly, claims 9-10, 12-13, 23-30 distinguish over Hertz taken alone and/or in view of Granik for this reason as well.

Rejection under 35 U.S.C. §103(a) Hertz in view of Burke and Stewart

As noted above, the Examiner rejected claims 14-19 under 35 U.S.C. §103(a) as being anticipated by Herz et al. (U.S. 6,571,279) in view of Burke et al (U.S. 6,604,681) and

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further in view of Stewart (U.S. 6,452,498).² As an initial matter, claims 17-19 have been cancelled without prejudice or disclaimer rendering the rejection to claims 17-19 moot.

Further, independent claim 14 has been amended to clarify over Hertz taken alone and/or in view of Burke and/or in view of Stewart by reciting:

requesting location data and user profile data from at least one mobile information processing unit, wherein the location data includes at least two records for determining a velocity of movement of the mobile information processing unit;

determining if the location data indicate if the mobile information processing unit is within a sales location and in response to the mobile information processing system being within the sales location forwarding to the mobile information processing system for display thereon, an interior map of the sales location which includes a personalized advertisement based upon the location data as well as user profile data associated with the mobile information processing unit, wherein the map provides directional information dependent on the velocity of movement of the mobile information processing system to a destination within the sales location linked to the advertisement.

For reasons stated above in the section entitled "Rejection under 35 U.S.C. §103(a) Hertz in view of Granik", Hertz taken alone taken alone and/or in view of Burke and/or in view of Stewart are silent on "wherein the location data includes at least two records for determining a velocity of movement of the mobile information processing unit" and "map provides directional information dependent on the velocity of movement of the mobile information processing system to a destination within the sales location linked to the advertisement."

² Applicants make no statement whether such combination is even proper.

Further in regards to claim 15, Hertz taken alone taken alone and/or in view of Burke and/or in view of Stewart are silent on

in response to the mobile information processing system being outside the sales location forwarding to the mobile information processing system for display thereon, a directional map to the sales location which includes a personalized advertisement based upon the location data as well as user profile data associated with the mobile information processing unit, wherein the map provides directional information dependent on the velocity of movement of the mobile information processing system to the sales location linked to the advertisement

For the foregoing reasons, independent claim 14 as amended distinguishes over Hertz taken alone and/or in view of Burke and/or in view of Stewart. Claims 15-16 depend from claim 14. Since dependent claims contain all the limitations of the independent claims, claims 15-16 distinguish over Hertz taken alone and/or in view of Burke and/or in view of Stewart as well, and the Examiner's rejection should be withdrawn.

CONCLUSIONS

The remaining cited references have been reviewed and are not believed to effect the patentability of the claims as amended.

In this response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

Applicants acknowledge the continuing duty of candor and good faith to the disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §§ 1.56, all such information is dutifully made of record. The foreseeable

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equivalents of any territory surrendered by amendment is limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

PLEASE, if for any reason the Examiner finds the application other than in condition for allowance, the Examiner is invited to call either of the undersigned attorneys at (561) 989-9811 should the Examiner believe a telephone interview would advance the prosecution of the application.

Respectfully submitted,

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